

REMARKS

Claims 1-6 and 8-11 are pending in this application. By this Amendment, claim 1 is amended and claims 7 and 12 are canceled. Support for the amendments to claim 1 may be found, for example, in the specification at page 1, lines 8-9, and at page 8, lines 13-15. No new matter is added.

Entry of the amendments is proper under 37 CFR §1.116 because the amendments:

(a) place the application in condition for allowance for the reasons discussed herein; (b) do not raise any new issue requiring further search and/or consideration as the amendments simplify issues previously discussed throughout prosecution; (c) do not present any additional claims without canceling a corresponding number of finally rejected claims; and (d) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented because they are made in response to arguments raised in the final rejection. Entry of the amendments is thus respectfully requested.

I. Rejections Under 35 U.S.C. §103

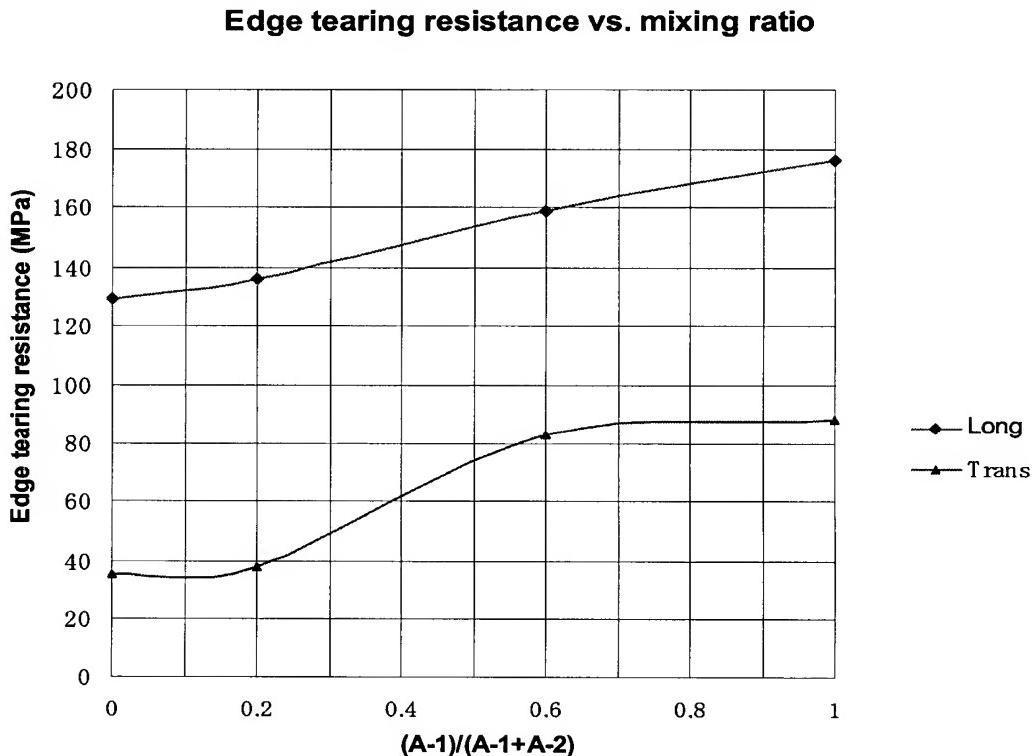
The Office Action rejects claims 1-12 under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 7,033,675 to Taniguchi et al. ("Taniguchi"). In addition, the Office Action also rejects claims 1-12 under 35 U.S.C. §103(a) as obvious over JP 2002-144436 ("JP '436"). By this Amendment, claims 7 and 12 are canceled, rendering their rejection moot. As to the remaining claims, Applicant respectfully traverses the rejection.

By this Amendment, claim 1 recites "wherein, the film having a heat bonding property at a temperature of 260 degrees C or lower and an edge tearing resistance of at least 40 MPa in both a longitudinal direction and a transversal direction." Neither Taniguchi nor JP '436 teach or suggest this feature, and one of ordinary skill in the art would have had no reason or rationale to have produced the claimed invention with the disclosures of Taniguchi or JP '436.

Thus, claim 1 would not have been rendered obvious by Taniguchi or JP '436 for at least this reason.

Moreover, under MPEP §2144.05(III), Applicants can rebut a *prima facie* case of obviousness based on overlapping ranges by showing the criticality of the claimed range. "In such a situation, the Applicant must show that the particular range is critical, generally by showing that the claimed range achieves unexpected results relative to the prior art range." (Emphasis added.) *In re Woodruff*, 919 F.2d 1575, 16 USPQ 2d 1934 (Fed. Cir. 1990).

Here, the claimed range provides unexpected results over the applied references. Applicant submits the following graph shown below, wherein "Long" stands for longitudinal, "Trans" for transversal, and $(A-1)/(A-1+A-2)$ is a weight ratio of (A-1) to a total weight of (A-1) and (A-2).



As shown in the graph, when the mixing ration of the resin components is (A-1)/(A-1+A-2), as claimed in claim 1, edge tearing resistance improves. Such improvement, particularly in a transversal direction, is unexpected.

On the other hand, Taniguchi teaches that PEI-1 has better crystallization properties and edge tearing resistance over PEI-2, and is the preferred resin. See Taniguchi at col. 11, table 1. JP '436 is silent on edge resistance. Thus, these results are unexpected in view of the applied references.

The Office Action asserts that one of ordinary skill in the art would have utilized routine experimentation based on the ranges of Taniguchi to yield the optimal ranges set forth in the pending claims. Applicants respectfully disagree.

One of ordinary skill in the art would have had no reason or rationale to have utilized routine experimentation to arrive at the claimed invention. As described in the present specification, the Applicant utilized soldering heat resistance after a Pressure Cooker Test. See specification at page 13, line 27 - page 14, line 7. However, this experimentation method would not have been considered routine, and neither Taniguchi nor JP '436 provide any reason for one of ordinary skill in the art to have utilized such a method.

In fact, had the experimentation of Taniguchi been utilized, only PEI-1 would have been selected, rather than a 50/50 ratio of the two resins. Comparative Example 1 does not contain PEI-2 (A-2), and shows blistering in the soldering heat resistance test after the pressure cooker test. See specification at page 16.

As neither Taniguchi nor JP '436 teach or suggest each and every feature of claim 1, one of ordinary skill in the art would have had no reason or rational to have developed the film of claim 1, the present application provides unexpected results over the applied references, and the method of experimentation described in the present specification would not have been considered routine, claim 1 would not have been rendered obvious by

Taniguchi or JP '436 for at least these reasons. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

II. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the application are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



William P. Berridge
Registration No. 30,024

Andrew B. Freistein
Registration No. 52,917

WPB:ABF/pjw

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OLIFF & BERRIDGE, PLC
P.O. Box 320850
Alexandria, Virginia 22320-4850
Telephone: (703) 836-6400

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